

**REMARKS**

Claims 21-28 were pending in the subject application, with claim 21 being the sole independent claim. Claims 1-20 were previously canceled, without prejudice or disclaimer. By this Amendment, claim 27 has been canceled, and claim 21 has been amended by incorporating the features formerly recited in claim 27. Applicants maintain that no new matter is presented by this amendment. Therefore, claims 21-26 and 28 are now pending.

**Rejection Under 35 U.S.C. §102(b) or Under 35 U.S.C. §103(a)**

On page 3 of the March 31, 2004 Office Action, claims 21, 22, 25, 26 and 28 were rejected under 35 U.S.C. §102(b) as allegedly anticipated by, or in the alternative under 35 U.S.C. §103(a) as obvious over, Japanese Patent Application No. JP 6-118726 (hereinafter "the '726 reference").

The Examiner stated that the '726 reference discloses a method in Example 14 ([0072]-[0075]) of making a liquid toner where ethylene-vinyl acetate copolymer (a thermoplastic resin), tin octylate (i.e., a metal soap), and silica having a 7 nm diameter and 300 m<sup>2</sup>/g specific surface area (i.e., Aerosil) are mixed in THF and heated to dissolve the resin and form a resin solution. The Examiner also stated that a pigment, wax, and poly-methyl-hydroxystearate are also mixed in THF to form a pigment dispersion liquid. The Examiner further stated that the resin solution and pigment liquid are combined and mixed and the temperature of the liquids is reduced to precipitate toner particles.

The Examiner stated that the particles are then dispersed in ISOPAR G to form the liquid toner. The Examiner also stated that the '726 reference states that the fine particles (e.g., silica) are made to exist in the olefin system resin particle. The

Examiner further stated that it appears this is the same structure that results in the electrorheological fluid of the instant specification.

The Examiner stated that Example 13 appears similarly applicable to the instant claims. The Examiner also stated that the silica additive is added with the pigment dispersion liquid rather than the resin solution, but these liquid components are combined and mixed before precipitation. The Examiner further stated that it appears that the liquids would be in a mixture in the same or substantially the same condition in Example 13 as Example 14.

The Examiner stated that the '726 reference also discloses the use of aluminum oxide and titanium oxide as the fine particles. The Examiner also stated that Example 9 ([0062]) shows zirconium octylate as an alternative tin octylate.

The Examiner acknowledged that the '726 reference does not state that the properties of an electrorheological fluid are imparted to the liquid toner.

The Examiner alleged, however, that it appears that the toner of the '726 reference would inherently have these properties because the toner is formed in the manner specified by the instant claims including heating of the resin so it dissolves, adding the silica particles, and cooling solution to precipitate the particles. The Examiner stated that the '726 reference describes the fine inorganic particles as being part of the resin particles, which is the same structure as required by the instant specification to give an electrorheological property.

The Examiner also alleged that it appears that the silica particles would inherently be present attached to or impregnated in at least the toner particle surfaces because each of the

requisite process steps to produce this feature is identically disclosed by the '726 reference and the materials (e.g., resin and silica) are disclosed by the specification as effective in the process. The Examiner stated that the claiming of a new use, new function or unknown property which inherently present in the prior art does not necessarily make the claim patentable.

Applicants submit that claim 21 as amended is patentable over the cited art.

On page 6 of the March 31, 2004 Office Action, the Examiner indicated that claim 27 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

By this Amendment, claim 27 has been canceled, and claim 21 has been amended by incorporating the features formerly recited in claim 27.

Therefore, claim 21 as amended is believed to be allowable for at least the reasons that would have rendered allowable claim 27 rewritten in independent form.

Regarding claims 22, 25, 26 and 28, Applicants respectfully point out that claims 22, 25, 26 and 28 depend on and include all the limitations of claim 21. Thus, claims 22, 25, 26 and 28 are patentable at least for the reasons set forth above with respect to claim 21.

Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 21, 22, 25, 26 and 28.

**Rejection Under 35 U.S.C. §103(a)**

On page 4 of the March 31, 2004 Office Action, claims 23 and 24 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over the '726 reference.

The Examiner acknowledged that the '726 reference does not identically disclose the claimed amount of antistat or dispersant in the reference liquid toner. The Examiner stated that the '726 reference states that the polyhydroxy carboxylate is added to aid dispersion of the pigment in the resin. The Examiner further stated that this component is a dispersant.

The Examiner stated that the amount of this component is 0.01 to 200 weight % of the resin weight. The Examiner also stated that the '726 reference discloses an amount of the tin octylate in Example 14 as 1.0 g along with 2.5 g of resin, 2.5 g of pigment, 0.09 g of carboxylate wax, and an amount of silica. The Examiner further stated that this example has about 16 weight % of the tin octylate based on the total solid components.

The Examiner alleged that it would have been obvious to one having ordinary skill in the art at the time the invention was made to use an amount of tin octylate in Example 14 based on the same solid amounts as in Example 1 because Example 1 shows that these component amounts are effective to give reduced picture flow. The Examiner also alleged that optimization of these material amounts is well within the level of skill in the art given the guidance present in the '726 reference. The Examiner further alleged that it would also have been obvious to optimize the amount of the carboxylate wax given the general teachings of the '726 reference and particularly in view of the Example 1 guidance where 1.6 weight % of the carboxylate is present based on the solids.

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The Examiner alleged that the artisan would expect similar amounts of the component to be effective in the other Examples where similar amounts of the other components are used. The Examiner stated that the '726 reference is seen as disclosing a component having an electrorheological fluid character because the additive fine particles are present in the tone particles. The Examiner further stated that this structure produces an electrorheological fluid according to the specification and the general disclosure of the '726 reference is seen as producing an electrorheological fluid.

For the reasons stated above, claim 21 as amended is believed to be patentable over the cited art. Since claims 23 and 24 depend on and include all the limitations of claim 21, claims 23 and 24 are patentable at least for the reasons set forth above with respect to claim 21.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 23 and 24 under 35 U.S.C. §103(a).

In view of the amendments to the claims and remarks hereinabove, Applicants maintain that claims 21-26 and 28 are now in condition for allowance. Accordingly, Applicants earnestly solicit the allowance of the pending claims.

If a telephone interview would be of assistance in advancing prosecution of the subject application, Applicants' undersigned attorneys invite the Examiner to telephone them at the telephone number provided below.

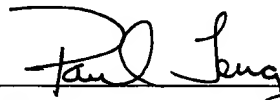
If a petition for an extension of time is required to make this response timely, this paper should be considered to be such a petition, and the Commissioner is authorized to charge the

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requisite fees to our Deposit Account No. 03-3125.

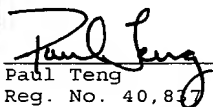
No fee is deemed necessary in connection with the filing of this Amendment. However, if any additional fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



Paul Teng  
Reg. No. 40,837

June 10, 2004  
Date